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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/691,416

10/22/2003

Patrick W. Kelley

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6171

7590

05/09/2006

Thomas E. Kelley  
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EXAMINER

SPEER, TIMOTHY M

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/691,416	KELLEY, PATRICK W.	
	Examiner	Art Unit	
	Timothy M. Speer	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claims 8 and 12 are objected to because of the following informalities: these claims are each concluded with two periods. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "not less greater than 3.5 inches" is unclear, rendering these claims indefinite. It is not clear whether applicant intends to claim that the diameter is less than or greater than the recited dimension.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christian (USPN 5,253,458) in view of Bonnema (USPN 4,913,473).**

Christian teaches simulated logs formed from a pipe made of PVC (polyvinyl chloride) (See abstract and col. 3, lines 31-38). Christian further teaches that the pipes are pre-cast with a

simulated log design to include knots, cracks and wood grains (e.g. having a diameter deviation). Christian fails to teach that the log is made of at least 80% thermoplastics comprising at least one of polyethylene or polypropylene and is silent on the diameter and length of the simulated log.

Bonnema teaches a large diameter molded plastic pipe which may be made of high-density polyethylene, PVC or polypropylene (col. 8, lines 46-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention, to substitute polypropylene or polyethylene thermoplastics that are disclosed in Bonnema for the PVC used in the simulated log taught by Christian since the reference specifically teaches that polypropylene or polyethylene may be substituted for PVC as a suitable material for making plastic pipes and because the Christian reference discloses that such plastic pipes are used to make the simulated logs.

With respect to the claimed diameter deviation, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See MPEP 2144.04. In the present case, the diameter deviation serve no mechanical functions, but are related to merely aesthetic purposes. Accordingly, this limitation is not seen to distinguish over the applied prior art.

Although Christian does not specifically disclose the claimed diameter or length of the simulated log, absent a showing of criticality, it would have been obvious to a person of ordinary skill in the art at the time of the invention to optimize the length and diameter (result effective variables) through routine experimentation. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). With regard to the claimed properties, it expected that the

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disclosed materials would exhibit these properties, since they are the same materials as claimed by applicant.

**6. Claims 1 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christian in view of Erwin (USPN 5,728,330).**

Christian was discussed above and fails to teach that the log is made of at least 80% thermoplastics comprising at least one of polyethylene or polypropylene and is silent on the diameter and length of the simulated log.

Erwin teaches simulated wood products comprising polyethylene, PVC or polypropylene outer layers (col. 4, lines 55-61). That is, Erwin teaches the functional equivalence of polyethylene, polypropylene and PVC in the manufacture of simulated wood products.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention, to substitute polypropylene or polyethylene thermoplastics that are disclosed in Erwin for the PVC used in the simulated log taught by Christian, since the reference specifically teaches that polypropylene or polyethylene may be substituted for PVC as a suitable material for simulated wood products, such as those disclosed by Christian.

With respect to the claimed diameter deviation, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See MPEP 2144.04. In the present case, the diameter deviation serve no mechanical functions, but are related to merely aesthetic purposes. Accordingly, this limitation is not seen to distinguish over the applied prior art.

Although Christian does not specifically disclose the claimed diameter or length of the simulated log, absent a showing of criticality, it would have been obvious to a person of ordinary

skill in the art at the time of the invention to optimize the length and diameter (result effective variables) through routine experimentation. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). With regard to the claimed properties, it expected that the disclosed materials would exhibit these properties, since they are the same materials as claimed by applicant.

**7. Claims 1 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin.**

Erwin teaches simulated wood products. The articles of Erwin comprise an outer polymer shell, wherein the polymer layer may be selected from polymers including polyethylene and polypropylene (abstract and col. 4, lines 55-61, for instance). Moreover, the polymer shell may comprise a mixture of these material and additional polymeric components. Therefore, it would have been obvious to one having ordinary skill in the art to form the product of Erwin from polyethylene, polypropylene or mixtures including these materials, as presently claimed, since Erwin suggests such materials. That being done, the recited flexural modulus would be inherent in the resulting product, since the product would be made from the same material as presently claimed.

With respect to the claimed diameter deviation, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See MPEP 2144.04. In the present case, the diameter deviation serve no mechanical functions, but are related to merely aesthetic purposes. Accordingly, this limitation is not seen to distinguish over the applied prior art.

Although Erwin does not specifically disclose the claimed diameter or length of the simulated products, absent a showing of criticality, it would have been obvious to a person of ordinary skill in the art at the time of the invention to optimize the length and diameter (result effective variables) through routine experimentation. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

***Response to Arguments***

8. Applicant's arguments filed 02/26/06 have been fully considered but they are not persuasive. Applicant argues that: 1) the Christian and Bonnema references are not analogous art; and 2) the Examiner has engaged in improper hindsight reconstruction of the claimed invention.

9. With respect to the analogous art argument, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Christian and Bonnema references are in the same field of endeavor; that being the formation of plastic tubing or piping employed in the construction field. Accordingly, applicant's arguments that the references seek to solve different problems are not well taken. Since the references are in the same field of endeavor, such arguments are not persuasive.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present case, the Examiner relies only on knowledge gleaned from the prior art in reaching a determination of obviousness. It is the teaching of the equivalence of PVC with PE and PP as taught in Bonnema upon which this determination resides and not any teaching gleaned from applicant's disclosure.

11. In light of the above, applicant's arguments have been fully considered but are not found to be persuasive.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy M. Speer



JENNIFER C. MCNEIL  
SUPERVISORY PATENT EXAMINER  
5/3/06